REMARKS

Claims 1 – 12, 14 – 20, 22 – 28, and 39 – 43 are pending in this application.

A Notice of Appeal is enclosed. No fee is due for this Notice of Appeal because the appeal fee was paid on April 25, 2005. An additional fee is believed not to be due because the application was withdrawn from appeal on the basis of an amendment made in the claims on April 14, 2003, well before the appeal was filed.

In a Final Office Action mailed April 4, 2006, the Examiner withdrew his rejection of the previous Office Action mailed January 12, 2006 on the grounds that new matter was introduced in an amendment made April 14, 2003, more than two years and five office actions ago. He then makes the rejection that the amendments filed by Applicant on January 24, 2006 contain new matter; i.e., that the specification does not support the recitations "wherein said foam plastic is 32% to 70% gas, by volume" of claim 39; "wherein said foam plastic is 40% to 70% gas, by volume" of claims 11 and 40; and "wherein said foam plastic is 50% to 70% gas, by volume" of claims 12 and 41. However, the 70% higher end of all the ranges and the 40% was in the original specification, and the 40% and 50% end point of the latter two ranges was in the original claims. The argument provided by the Examiner allegedly as a "New Rejection" in section 11 of the Office Action is only that the lower end point of 32% made in the amendment of April 14, 2003 is new matter. Thus, it is respectfully submitted that the "New Rejection" in the Office Action of January 12, 2006 is simply a repeat of the previous rejection, and is traversed for the reasons given in the response filed January 24, 2006. This distinction is being made not to argue with the Examiner, but because it is believed necessary so that an additional Appeal Fee will not be due as indicated above.

The Office Action states that the facts of *In re Wertheim* (541 F.2d 257, 191 USPQ 90 [CCPA 1976]) are not applicable to the present application because Wertheim had an example of 36%, whereas the present application does not have an example of 32%. However, the decision in Wertheim related to the fact that the amendment was "at least 35%" and "at least" had no upper limit, which took it outside the 60% upper limit disclosed in the application. Contrary to what the Office Action states, Wertheim and MPEP 2163.05III expressly state that a range of 35% to 60% did meet the description requirement, even though there was no example of 35% in Wertheim. Further, the 32% limit is within the range taught by the present application. Moreover, the Office Action states that the amendment was made to avoid the prior art, but does not respond to the

argument of the Applicant in the last response that this type of amendment has always been viewed by the USPTO and the courts as a narrowing amendment and deemed to be supported by the specification under 35 USC §112. See *Reens Bros., Inc. v U.S. Laminating Corp.*, 157 USPQ 235, 245, at headnote 7. For these reasons, the new matter rejection of the Office Action is not appropriate, and it is respectfully requested that this rejection be withdrawn.

Claims 1 - 12, 14 - 20, 22 - 28, and 39 – 42 were rejected under 35 U.S.C. 103(a) and remain rejected for the reasons made of record in paragraphs 8 – 14 of the previous Office Action mailed January 12, 2006. A full response to these reasons was made of record in the response filed January 24, 2006 and is incorporated herein by reference. The Response to Arguments on pages 4 – 9 of the Office Action of April 4, 2006 has been thoroughly reviewed, but does not appear to present any new issues. The Office Action argues that Sobolev considers each of the foaming agents, microballoons, and blowing agents to be a filler, and teaches a specific gravity range of the "filled resin core" is about 0.8 to 1.3. This does not teach a core reduction of 32%, nor does the Office Action argue this. Moreover, Sobolev only teaches that this range of specific gravity is "desired". It does not teach that it can be accomplished. Moreover, immediately following the cited statement at column 12, lines 10 – 24, it teaches that, to reach this range of densities, microballoons are desired. It does not say that this range can be reached with foam. For this reason, the cited portion of Sobolev actually supports patentability since it shows this was desirable, but not attainable with foam. In addition, those skilled in the art would not look to Sobolev for what was desirable, but for what Sobolev taught was attainable. Those skilled in the art, after reading this section, would elect to use microballoons, not foam. Moreover, this and the other of the responses to arguments of the Office Action of April 4, 2006 merely shift to Applicant the burden of proving that the claims are patentable. In the prior response, the Applicant provided reasons why the previous Office Action had not provided a prima facie case of obviousness. The burden is not on the Applicant to prove the claims are patentable, but rather the burden is on the United States Patent and Trademark Office to provide a prima facie case of obviousness, which, as shown in the prior response, has not been done. MPEP 2142. A desired condition that is not taught to be attainable does not support obviousness.

In view of the above amendments and remarks, Applicant believes the pending application is in condition for allowance. Applicant believes no fee is due with this response.

Application No. 09/993733
Amendment dated June 28, 2006
After Final Office Action of April 4, 2006

Docket No.: 013190.0101PTUS

However, if a fee is due, please charge our Deposit Account No. 50-1848, under Order No. 013190.0101PTUS from which the undersigned is authorized to draw.

Dated: 6/28/06

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